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| 10/049,188      | 02/08/2002  | Tomoaki Yoshida      | Q63028              | 8127             |

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EXAMINER

CANTELMO, GREGG

ART UNIT PAPER NUMBER

1745

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/049,188

Applicant(s)

YOSHIDA ET AL.

Examiner

Gregg Cantelmo

Art Unit

1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6,9-12,14-24 and 26-30 is/are pending in the application.
- 4a) Of the above claim(s) 2-6,9-12,14-16 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,17-24,26,27,29 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Amendment***

1. In response to the amendment received June 17, 2004:
  - a. Claims 1-6, 9-12, 14- 24 and 26-30 are pending. Claims 7, 8, 13 and 25 have been cancelled as per Applicant's request. Claims 2-6, 9-12, 14-16 and 28 have been withdrawn from consideration (non-elected claims from the previous restriction). Action on the merits of claims 1, 17-24, 26, 27 and 29-30 is provided herein;
  - b. With respect to the instant Applications claims for priority benefits, items 3 and 4 of the previous office action have been withdrawn in light of Applicant's comments and in light of the translation of the provisional application identified in item 4 of the previous office action. Item 5 of the previous office action stands as having not been sufficiently overcome by Applicant's response. A detailed response to item 5 of the previous office action is set forth below;
  - c. The claim objections have been overcome in light of the amendment to the claims;
  - d. The 112 rejection has been withdrawn in light of further consideration;
  - e. The prior art rejections of record have been withdrawn in light of the amendment to the claims.

***Priority***

2. As set forth in item 5 of the previous office action:

This application claims benefit to a provisional application No. 60/308,855, filed

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on August 1 2001 , in a language other than English. Applications that claim benefit of a provisional application filed in a non-English language must include an English translation of the non-English language provisional application and a statement that the translation is accurate. See 37 CFR 1.78(a)(5). The English translation and a statement that the translation is accurate as required by 37 CFR 1.78(a)(5) is missing. Applicant must supply the missing English translation and a statement that the translation is accurate in the reply to this Office action prior to the expiration of the time period set in this Office action.

***Response to Arguments***

3. Applicant's arguments filed June 17, 2004 have been fully considered but they are not persuasive.

a. Applicant states that a translation of this provisional application was filed directly in the provisional Application itself.

A review of the U.S. patent Office file regarding Provisional Application No. 60/308,855 failed to include any such translation.

b. Applicant additionally states that the response provided June 17, 2004 includes a copy of the stamped filing receipt acknowledging item 3a above.

However the response of June 17, 2004 received by the U.S. Patent Office does not include any such copy.

Thus the written record fails to have clearly established priority to this provisional application.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 21-24, 26 and 29-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Each independent claim recites "an electrode ... the electrode being provided on each surface of the electrolyte membrane." There is no support for the electrode being provided on both sides of the electrolyte membrane, rather the disclosure supports providing first and second electrodes on opposing sides of the electrolyte membrane to form the MEA.
6. Claims 21-24, 26 and 29-30 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for first and second electrodes formed on opposite sides of the electrolyte membrane of the MEA, does not reasonably provide enablement for forming "an electrode ... the electrode being provided on each surface of the electrolyte membrane.". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.
7. Claims 21-24 and 26 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the catalyst layer having conductive powder

particles, does not reasonably provide enablement for the surface of the gas diffusion layer in contact with the catalyst layer including conductive powder particles. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The conductive powder particles disclosed in the instant application are found in the catalyst layer and at best appear to contact a surface of the gas diffusion layer (See Fig. 6). However the gas diffusion layer itself is void of conductive particle powers.

8. Claims 21-24 and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The conductive powder particles disclosed in the instant application are found in the catalyst layer and at best appear to contact a surface of the gas diffusion layer (See Fig. 6). However the gas diffusion layer itself is void of conductive particle powers. The claims have been interpreted in light of the specification in that the conductive powder particles defined in these claims are from the catalyst layer as shown in Fig. 6.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 21-24, 26 and 29-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear whether the claims intend to define first and second electrodes on opposing sides of the electrolyte membrane as supported by the written description or of "an electrode" whereby "the electrode being provided on each surface of the electrolyte membrane."

The claim has been interpreted as the former and if this is accurate, the claims should be amended to clarify the electrode(s) arrangement in the claims.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP 62-287571-A (JP '571).

JP '571 discloses a gas diffusion electrode comprising water repellant PTFE layer with vapor grown carbon fibers. The gas diffusion electrode used in a battery is provided with a catalyst layer to impart the requisite catalytic activity to the electrode. An in-house oral translation of JP '571 shows that the carbon fibers have a thickness of 200-500 Angstroms, which is equivalent to 20-50 nanometers (see underscored text on page 323 of JP '571 as applied to claim 1).

A certified translation of this document has been submitted and will be furnished upon receipt of the translation.

***Response to Arguments***

13. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejections.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1, 17, 18, 21, 27, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 184638-A2 (EP '638 in view of JP 62-287571-A (JP '571)).

EP '638 discloses a fuel cell and membrane electrode assembly (MEA) wherein the MEA comprises an electrolyte membrane 11, an electrode 3 or 8 including a catalyst layer 5 or 10, respectively, and gas diffusion layer 4 or 9, respectively, with the electrodes being provide on each surface of the electrolyte membrane 11 wherein at least a portion of the gas diffusion layers 4 and 9 are in contact with the catalyst layers 5 and 10, respectively and include a hydrophobic resin (polytetrafluoroethylene) and carbon fibers (Fig. 1 and abstract as applied to claims 1, 17, 21 and 29). Separators 1 and 6 sandwich the MEA (Fig. 1 as applied to claim 29).

The catalyst layer, including the boundary between the catalyst layer and gas diffusion layer includes conductive particles such as carbon black which is applied to the



electrodes in the form of a paste. Since the gas diffusion electrode is porous, at least a portion of the catalyst paste will penetrate the boundary between the gas diffusion layers and catalyst paste layers (paragraph bridging pages 13 and 14, page 28 and page 29 as applied to claims 18 and 21).

The resin is polytetrafluoroethylene (abstract as applied to claim 27).

The arrangement is provided in a fuel cell stack and thus comprises layering at least 2 cells together (page 1 and paragraph bridging pages 16 and 17 of EP '638 as applied to claim 30).

The difference between claims 1, 17, 21 and 29 and EP '638 is that EP '638 does not disclose of the carbon fiber being a vapor grown fiber having a fiber filament of 10-300 nm (claims 1, 17, 21 and 29).

JP '571 discloses a gas diffusion electrode wherein the electrode comprises PTFE and vapor grown carbon fibers having a fiber filament of 200-500 Angstroms, or 20-50 nm (abstract and underscored text on page 323 of JP '571 as applied to claims 1, 17, 21 and 29).

The motivation for using the gas diffusion layer of JP '571 is that it improves the gas permeability and electrical conductivity of the gas diffusion layer.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of EP '638 by using the gas diffusion layer as taught by JP '571 since it would have improved the gas permeability and electrical conductivity of the gas diffusion layer.

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16. Claims 1, 17, 18, 21-24, 26, 27, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 184638-A2 (EP '638) in view of JP 62-287571-A (JP '571) and U.S. patent No. 6,489,026 (Nishimura).

EP '638 discloses a fuel cell and membrane electrode assembly (MEA) wherein the MEA comprises an electrolyte membrane 11, an electrode 3 or 8 including a catalyst layer 5 or 10, respectively, and gas diffusion layer 4 or 9, respectively, with the electrodes being provide on each surface of the electrolyte membrane 11 wherein at least a portion of the gas diffusion layers 4 and 9 are in contact with the catalyst layers 5 and 10, respectively and include a hydrophobic resin (polytetrafluoroethylene) and carbon fibers (Fig. 1 and abstract as applied to claims 1, 17, 21, 22 and 29). Separators 1 and 6 sandwich the MEA (Fig. 1 as applied to claim 29).

The catalyst layer, including the boundary between the catalyst layer and gas diffusion layer includes conductive particles such as carbon black which is applied to the electrodes in the form of a paste. Since the gas diffusion electrode is porous, at least a portion of the catalyst paste will penetrate the boundary between the gas diffusion layers and catalyst paste layers (paragraph bridging pages 13 and 14, page 28 and page 29 as applied to claims 18 and 21).

The resin is polytetrafluoroethylene (abstract as applied to claim 27).

The arrangement is provided in a fuel cell stack and thus comprises layering at least 2 cells together (page 1 and paragraph bridging pages 16 and 17 of EP '638 as applied to claim 30).

The differences between claims 1, 17, 21-24, 26 and 29 and EP '638 are that EP '638 does not disclose of the carbon fiber being a vapor grown fiber having a fiber filament of 10-300 nm (claims 1, 17, 21, 22 and 29); of forming the fiber through heat treatment at a temperature of at least 2000°C (claim 23), of the fiber containing boron in an amount from 0.01-10mass% (claim 24), of the fiber having a filament length of less than 100 microns (claim 26).

With respect to the vapor grown carbon fiber having a fiber filament of 10-300 nm (claims 1, 17, 21, 22 and 29):

JP '571 discloses a gas diffusion electrode in a fuel cell wherein the electrode comprises PTFE and vapor grown carbon fibers having a fiber filament of 200-500 Angstroms, or 20-50 nm (abstract and underscored text on page 323 of JP '571 as applied to claims 1, 17, 21, 22 and 29). Nishimura discloses vapor grown carbon fibers in a electrodes wherein the fibers are dimensioned from 0.01-1 micron (col. 5, ll. 53-56), preferably 0.5 microns or less (col. 6, ll. 5-6 as applied to claims 1, 17, 21, 22 and 29).

The motivation for using the gas diffusion layer of JP '571 is that it improves the gas permeability and electrical conductivity of the gas diffusion layer.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of EP '638 by using the gas diffusion layer as taught by JP '571 since it would have improved the gas permeability and electrical conductivity of the gas diffusion layer.

With respect to the % mass of the carbon fiber (claim 22):

Nishimura discloses vapor grown carbon fibers used in gas diffusion electrodes wherein the fibers are present in the electrode in an amount up to 20 mass % (col. 11, ll. 48-54).

The motivation for providing up to 20 mass % of the vapor grown carbon in the electrode layer is that it optimizes the charge-discharge capacity of the battery produced.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of EP '638 by providing up to 20 mass % of the vapor grown carbon in the electrode layer since it would have optimized the charge-discharge capacity of the battery produced.

With respect to the temperature of forming the carbon fiber (claim 23):

Nishimura discloses heating the carbon to temperatures of at least 2000°C (abstract).

The motivation for heating the carbon to temperatures of at least 2000°C is that it enhances the crystallinity of the carbon (col. 2, ll. 15-25 and col. 3, ll. 1-9).

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of EP '638 by heating the carbon to temperatures of at least 2000°C since it would have enhanced the crystallinity of the carbon.

With respect to the fibers containing boron in an amount of 0.01-10 mass% (claim 24):

Nishimura discloses that a boron additive is provided during the heat crystallization of the vapor grown carbon fibers as a catalytic material (col. 7, ll. 58-61) with the end carbon product having 0.1 to 10 mass% boron therein (col. 4, ll. 34-38).

The motivation for providing boron in the amount taught by Nishimura and recited in the instant claim is that it provides a catalytic material which enhances the crystallization of the carbon fibers.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of EP '638 by providing boron in the amount taught by Nishimura and recited since it would have provided a catalytic material which enhances the crystallization of the carbon fibers.

With respect to the length of the fibers (claim 26):

Nishimura discloses that the fiber length is preferably no more than 100 microns. And by example when the fiber diameter is 0.01 microns (10 nm) the fiber length is 0.5 microns (col. 6, ll. 13-19).

The motivation for controlling the aspect ratio is that it provides a fiber which has sufficient length to provide good mechanical strength and electrical conductivity along the fibers while providing good dispersability of the fibers in the electrode.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of EP '638 by controlling the aspect ratio since it would have provided a fiber which has sufficient length to provide good mechanical strength and electrical conductivity along the fibers while having also provided good dispersability of the fibers in the electrode.

17. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP '638 in view of JP '571 and Nishimura as applied to claims 17 and 18 above, and further in view of U.S. patent No. 5,861,222 (Fischer).

The difference not yet discussed is of the spaces arrangements of claims 19-20.

Fischer discloses of a gas diffusion layer comprising a bimodal pore distribution and wherein the total porosity of more than 40% to less than 75% is composed of small pores with an average diameter of up to 0.5 microns and large pores with an average diameter of 1 to 20 microns.

The motivation for providing the porosity of Fischer to the gas diffusion layer of EP '638 is that it enhances the diffusive characteristics of the gas diffusion layer while maintaining adequate mechanical strength to the layer.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of EP '638 by providing the porosity of Fischer to the gas diffusion layer of EP '638 since it would have enhanced the diffusive characteristics of the gas diffusion layer while maintained adequate mechanical strength to the layer.

### ***Response to Arguments***

18. Applicant's arguments with respect to claims 1, 17-24, 26, 27 and 29-30 have been considered but are moot in view of the new ground(s) of rejections.

### ***Conclusion***

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPAT 4,663,230 (Tennent) discloses a composite of carbon

fibers and a hydrophobic resin. USPAT 5,865,968 (Denton) discloses a gas diffusion electrode comprising carbon fibers and a hydrophobic resin. USPAT 6,531,240 (Brown) discloses a gas diffusion electrode comprising carbon fibers and a hydrophobic resin. U.S. Patent Application Publication No. 2002/0051903 (Masuko) discloses forming carbon fibers used in electrodes. JP 62-246813-A discloses producing graphite having a minor amount of boron therein. JP 05-221621-A discloses forming vapor grown carbon materials for electrodes. JP 2000-273351-A discloses graphitizing carbon black under high temperature conditions in the presence of a boron compound catalyst. JP 08100328-A discloses producing carbon fibers by vapor phase.

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregg Cantelmo whose telephone number is (571) 272-1283. The examiner can normally be reached on Monday to Thursday from 9 a.m. to 6 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan, can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. FAXES received after 4 p.m. will not be processed until the following business day. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregg Cantelmo  
Primary Examiner  
Art Unit 1745

gc

  
September 16, 2004